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In re Application of	:
Michael Schmidt et al	:
Serial No.: 09/877,259	: PETITION DECISION
Filed: June 11, 2001	:
Attorney Docket No.: MERCK2272	:

This is in response to the petition under 37 CFR 1.144, filed July 15, 2005, requesting withdrawal of an improper restriction requirement.

#### BACKGROUND

A review of the file history shows that a petition decision with regard to a previous restriction requirement was mailed to applicants on July 30, 2004, which contained a file history to that point in time and granted applicants request to withdraw the restriction requirement as based on a proper combination/subcombination relationship. The decision did not prohibit a different type of restriction requirement being made.

In view thereof a new examiner mailed a new Office action to applicants on November 15, 2004, setting forth a new restriction requirement, as follows:

Group I – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a pyridinium ring, and an electric cell and capacitor utilizing the ionic liquid;

Group II – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a pyridazinium ring, and an electric cell and capacitor utilizing the ionic liquid;

Group III – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a pyrimidinium ring, and an electric cell and capacitor utilizing the ionic liquid.

Group IV – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a pyrazinium ring, and an electric cell and capacitor utilizing the ionic liquid;

Group V – Claims 1-20, drawn to an ionic liquid where  $K^+$  is an imidazolium ring, and an electric cell and capacitor utilizing the ionic liquid;

Group VI – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a thiazolium ring, and an electric cell and capacitor utilizing the ionic liquid;

Group VII – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a oxazolium ring, and an electric cell and capacitor-utilizing the ionic liquid;

Group VIII – Claims 1-11 and 14-20, drawn to an ionic liquid where  $K^+$  is a 1,2,4-triazolium ring, and an electric cell and capacitor utilizing the ionic liquid.

The examiner argued that the various groups were separate and distinct and consideration of all would impose an undue burden on the Office. The examiner also required an election of species within the group elected.

Applicants replied on December 1, 2004, adding claims 21-28, electing Group V and a species within the Group and traversing the requirement as unjust in that all of the species were treated by the previous examiner and that restricting within a claim is improper. Also, that where all of the compounds are linked together, as here, by a common anion restriction is improper and that these cations can all be found in a single document.

The examiner mailed a non-Final Office action to applicants on February 16, 2005, noting applicants' traversal thereof and responding to it. The requirement was made Final. The examiner then rejected claim 25 under 35 U.S.C. 112, first paragraph, for lack of written description and claims 1-20 and 25 under 35 U.S.C. 112, second paragraph, as indefinite. Claims 1-11, 14-18 and 25 were rejected under 35 USC 103(a) as unpatentable over Koch et al in view of Heider et al ('454 and '212) and Hilarius et al.

Applicants replied on July 15, 2005, by amending claims 1, 3, 14 and 21-28. Applicants responded to each of the rejections. Applicants also filed this petition to address the restriction requirement.

## DISCUSSION

Applicants request that the restriction requirement be reviewed with respect to the decisions of *In re Haas et al* and *In re Weber et al*, as to whether restriction within a claim is proper. Applicants argue that the decisions reflect that it is improper to restrict within a claim as that in effect prevents full examination of that claim. However, the subject matter within a claim containing a Markush group must have unity within the subject matter claimed. Applicants then suggest that the subject matter should be examined under the guidelines of M.P.E.P. 803.02 in that the examiner should have required an election of species. Applicants further suggest that Anion A which is not a variable of the magnitude of K should be considered the core or unifying structure and be searched first to see if any of the structures represented by K are associated with it.

Applicants' arguments are noted. Applicants' understanding of *In re Haas et al* and *In re Weber et al* is generally correct. Where there is a unifying concept in a Markush group restriction is improper, although election of species is permitted in order to identify a starting point for examination of large Markush groups. (However, where there is no unifying concept restriction within a Markush group is permitted.) Here the compound is comprised of two parts: A is a fluoro organophosphorous anion of relatively simple construction; variable K is comprised of various heterocyclic cations. As suggested by applicants unity is provided by the relatively invariant anion. Thus restriction within the Markush group, in this instance, is improper. The examiner's restriction requirement will be considered as an election of species requirement where the species have been identified by their base ring structure. As applicants have elected a

species and examination on the species has proceeded with the species currently being rejected over prior art, no further remedy need be considered at this time.

#### DECISION

The petition is **GRANTED**. The restriction requirement is redesignated as an election of species requirement to which a proper response has been made.

**The application will be forwarded to the examiner for consideration of the amendment filed July 15, 2005, and further action not inconsistent with this decision.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in cursive script, reading "George C. Elliott".

George C. Elliott  
Director, Technology Center 1600